

### REMARKS

Claims 1-22 are pending, with claim 1 being the sole independent claim.

### RESTRICTION REQUIREMENT

The Examiner has required restriction to one of the following inventions under 35

U.S.C. 121:

I) Claims 1-18, drawn to a poly(phenylene ether) resin composition, classified in class 525, subclass 390.

II) Claims 19 and 20, drawn to a prepreg, classified in class 428, subclass 411.1.

III) Claims 21 and 22, drawn to a laminated sheet, classified in class 428, subclass 141.

### ELECTION

In order to be responsive to the requirement for restriction, Applicant elect the invention set forth in Group III drawn to a laminated sheet, claims 21 and 22, with traverse.

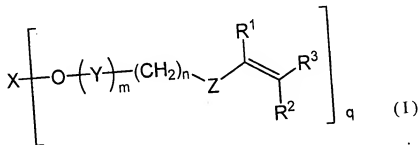
### TRAVERSE

Notwithstanding the election of the claims of Group III in order to be responsive to the Restriction Requirement, Applicants respectfully traverse the requirement for restriction.

Initially, it is noted that the requirement for restriction omits one of the two criteria of a proper requirement as now established by U.S. Patent and Trademark Office policy, as set forth in MPEP 803, viz. that "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if a restriction were not required. Due to the aforementioned omission, it is respectfully submitted that the requirement for restriction is improper and, consequently, its withdrawal is respectfully requested.

Related to this, the requirement is traversed since there would not be a serious burden to examine Applicants' application in total, and for which the appropriate claim fees have been paid. Applicants submit that it would be no serious burden on the Examiner to examine all of the pending claims, because a search for all of the claims in the above-identified application, should be made in order to do a complete and thorough search in view of the recognized relationship between the claims in Groups I, II and III.

For example, Applicants note that claim 1 is directed to a poly(phenylene ether) resin composition comprising a poly(phenylene ether) and a crosslinking curing agent, wherein said polyphenylene ether is represented by the following formula (I), and the number averaged molecular weight thereof is in a range of 1,000 to 7,000.



[wherein, X is an aryl group; (Y)<sub>m</sub> is a polyphenylene ether moiety; Z is a phenylene group, an oxygen atom or a sulfur atom; R<sup>1</sup> to R<sup>3</sup> each independently is a hydrogen atom,

an alkyl group, an alkenyl group or alkynyl group; n is an integer of 1 to 6; and q is an integer of 1 to 4.]

Claim 19 in Group II depends upon claim 1 in Group I, and is directed to a prepreg prepared by impregnating the poly(phenylene ether) resin composition according to Claim 1 into a substrate and semi-curing the resulting impregnated substrate.

Claim 21 in Group III depends upon claim 19 in Group II, and is directed to a laminated sheet prepared by piling the prepreg according to claim 19 and copper foil(s) one over the other under heat-pressing.

The difference between these inventions should not be considered to be material for restriction requirement and examination purposes, and the search for each group of claims should include similar, if not the same, art areas.

Because a search of each of the inventions would appear to be at least related, and should certainly overlap if not actually be coextensive, there would be no serious burden on the Examiner to examine all of the claims in this application. For this reason, and consistent with Office policy set forth in MPEP 803, Applicants respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

Furthermore, Applicants respectfully submit that the claims in the groups of invention should be considered as combination/subcombination type claims. The Examiner is reminded that in order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary. The requirement must establish that the combination as claimed (A) does not require the particulars of the subcombination as claimed for

patentability, and (B) the subcombination can be shown to have utility either by itself or in other and different relations. Under the present circumstances, the claims are dependent upon each other, so that restriction is not appropriate.

In view of the foregoing, it is respectfully requested that the Examiner seriously reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.

CONCLUSION

For the reasons discussed above, it is respectfully submitted that the requirement for restriction is improper and should be withdrawn.

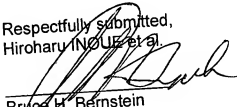
Withdrawal of the requirement for the restriction with the examination of all claims pending in this application is respectfully requested.

Favorable consideration with early allowance of the pending claims is most earnestly requested.

If the Examiner has any questions, or wishes to discuss this matter, please call the undersigned at the telephone number indicated below.

August 15, 2005  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191

Respectfully submitted,  
Hiroharu INOUE et al.

  
Bruce H. Bernstein  
Reg. No. 29,027

Arnold Turk  
Reg. No. 33,094